

## REMARKS

### I. INITIAL REMARKS

In response to the Examiner's rejection of claims 1-2 under 35 U.S.C. §112 second paragraph as indefinite for failing to point out and distinctly claim the subject  
5 matter which applicant regards as the invention, the Applicant has amended claim 1 (see page 2) to comply with the examiner's interpretation.

In response to the Examiner's rejection of claims 1, 3-5 under 35 U.S.C. §103(a) as unpatentable over Baxley *et al.*, U.S. Publication No. 2004/0085913 (hereinafter "Baxley"), in view of Kung *et al.*, U.S. Patent No. 6,671,262 (hereinafter "Kung")  
10 Applicants present the following arguments.

In response to the Examiner's rejection of claim 2 under 35 U.S.C. §103(a) as unpatentable over Baxley and Kung, in view of Goldstein, U.S. Patent No. 6,940,971 (hereinafter "Goldstein"). Applicants have withdrawn claim 2.

In light of the comments that follow, the rejections and objections in the August  
15 10, 2005 Office Action have been overcome and should be withdrawn.

### II. THE EXAMINER'S REJECTIONS

The Examiner has rejected claims 1, 3-5 under 35 U.S.C. §103(a), as being unpatentable over Baxley in view of Kung. The Examiner cites Baxley as teaching  
20 elements (3) – (7) and the eighth clause of claim 1. However, the Examiner concedes that while Baxley teaches a single server serving as both a packet-switch and a circuit-switch conferencing server but fails to teach "a separate packet-switch conferencing server and a circuit switched conferencing server, thereby establishing by a packet-

switched conferencing server, a connection to a circuit-switched conferencing server; designating said connection as an active speaker on said packet-switched conferencing server; and forwarding, over said connection, said second audio packet to said circuit-switched conferencing server.” Office Action dated September 29, 2005, pages 3-4.

5           Subsequently, the Examiner proposes that Kung teaches audio conferencing between IP and PSTN networks. The Examiner then suggested that it would have been obvious for one of ordinary skill in the art to combine Baxley and Kung because “both teachings are similar in that they deal with audio conferencing between users of a circuit switch network and a packet switch network.” Office Action dated September 29, 2005,  
10   page 4.

### III.    THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

          In order for a claimed invention to be obvious, either alone or in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or  
15   motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MANUAL OF PATENT EXAMINING PROCEDURE § 2143-2143.03.

          Applicants respectfully submit that no combination of references teach the claim  
20   limitations of the present invention.

          The Examiner’s rejection relies on Baxley as showing a system with a system and method teaching elements (3)-(7) and the eighth clause of claim 1 and cites Kung as showing audio conferencing between IP network users and PSTN network users having a

plurality of conferencing servers. The present invention teaches the use of multiple MCUs, at least one separate packet-switch conferencing server and at least one separate circuit-switch conferencing server.

The system taught by Baxley does not obviate the present invention when viewed  
5 in light of Kung's conferencing. Since the combination of Baxley and Kung fails to teach each and every claim limitation, the Examiner's rejections should be withdrawn.

In addition, an obviousness rejection is improper unless the prior art relied upon suggests the proposed combination. *See In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Indeed, the Examiner "has the burden to show some teaching or  
10 suggestion in the references to support their use in the particular claimed combination."  
*SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988); *see also, In re Mayne*, 104 F.3d 1339, 1342, 41 USPQ2d 1451, 1454 (Fed. Cir. 1997) ("When relying on numerous references or a modification of prior art, it is incumbent upon the examiner to identify some suggestion  
15 to combine references of make modification."). A finding of obviousness is not warranted if, as in the present case, there is an absence of such teaching, suggestion or motivation. *See Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). The prior art references relied upon by the Examiner fail to provide any teaching, suggestion or motivation for the combination  
20 asserted by the Examiner in rejecting the pending claims. It is well settled that:  
"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is

some suggestion or incentive to do so.” *ACS Hospital Systems Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

Specifically, Applicants respectfully submit that there is no motivation for the combination of Baxley and Kung. According to MPEP §2143.01, the fact that a claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by  
5 itself to establish *prima facie* obviousness. Indeed, “a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach all aspects of the claimed invention were individually known in the art is not  
10 sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” MPEP §2143.01; *see also Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App & Inter. 1993).

In the present rejection, the Examiner stated, with respect to the combination of Baxley and Kung “ [i]t would have been obvious ... to combine ... because both  
15 teachings are similar in that they deal with audio conferencing between users of a circuit switch network and a packet switch network.” Office Action dated September 29, 2005, page 6. In short, the Examiner stated that it would have been obvious to combine because the teachings are merely similar. However, nothing in the references suggest an objective reason to combine the references. In addition, the Examiner has not offered any  
20 rationale for combining Baxley and Kung. Without such an objective reason, combining these references is improper. Therefore, the rejection of the claims should be withdrawn.

The cited references provide no such motivation or incentive for the combination suggested by the Examiner. Therefore, the obviousness rejection could only be the result

of a hindsight view with the benefit of Applicant's specifications. This type of analysis is inappropriate:

5            "To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. The invention must be viewed not after the blueprint has been drawn by the inventor, but as it would have been perceived in the state of the art that existed at the time the invention was made." *Seasonics v. Aerosonic Corp.* 38 USPQ 2d 10    1551, 1554 (1996) (citations omitted).

In addition, the combination advanced by the Examiner is not legally proper -- on reconsideration the Examiner will undoubtedly recognize that such a position is merely an "obvious to try" argument.

15            At best, it might be obvious to *try* such a modification, but of course, "obvious to try" is not the standard for obviousness under 35 U.S.C. § 103. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 91 (Fed. Cir. 1986).

Under the circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." *Orthopedic Equipment Co. v. United States*, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983):

20            "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarter backing is quite improper when resolving the question of non-obviousness in a court of law." *Id.*

25            Applicants submit that the only "motivation" for the Examiner's combination of the references is provided by the teachings of Applicant's own disclosure. No such motivation is provided by the references themselves.

30            Thus, the present invention, for the first time, discloses a novel method and system for managing high-bandwidth data sharing. This represents a vast improvement

over the prior art, and is not taught or disclosed anywhere in the prior art. Further, the cited references neither teach nor suggest the novel and nonobvious features of this invention.

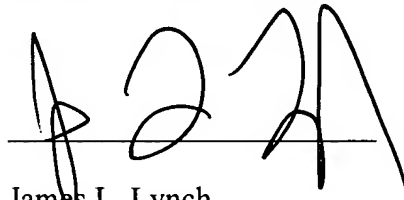
Therefore, the combination of references is not proper and the rejection of the  
5 claims should be withdrawn.

#### IV. CONCLUSION

Applicant submits that pending claims 1 and 3-5 represent a patentable contribution to the art and is in condition for allowance. Early and favorable action is  
10 accordingly solicited.

Date 12-28-2005

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. Lynch', written over a horizontal line.

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